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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,978	08/21/2000	Norman William MacLeod	P0557/7030	6678

7590

06/04/2003

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EXAMINER

LEE, EDMUND H

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,978

Applicant(s)

MACLEOD, NORMAN WILLIAM

Examiner

EDMUND H LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,41,42 and 44-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,41,42 and 44-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/2/03 has been entered.
2. Claims 21, 41, 42, and 44-49 are pending in the instant application.
3. Claims 21, 41-42, and 44-49 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for 1) providing a forming last including a body having the general shape of a foot around which an upper of a footwear item is formed in a series of separate operations, the last body having a base corresponding to a sole of the foot shape, 2) providing an apparatus having a plurality of separate workstations for performing discrete upper fabrication operations and a molding workstation for molding a rubber sole, 3) removably mounting a forming last on the apparatus to form the upper thereon, 4) moving the forming last sequentially through the plurality of separate workstations of the apparatus to form the upper thereon, 5) once the upper is completed, removably mounting the forming last with the formed and completed upper thereon onto the molding workstation for molding a rubber sole onto the formed and completed upper, and 6) molding a rubber sole onto the formed upper

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while it is still on the forming last, the forming last being heated before and/or during the molding step, wherein the step of heating the forming last includes heating the base of the last body while substantially preventing the heating of the parts of the last body other than the base, does not reasonably provide enablement for 1) removably mounting a forming last with *the formed upper* on the apparatus, and 2) moving the last *with the formed upper thereon sequentially through the plurality of separate workstations* to the molding workstation. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. It is clear from the instant specification that the forming last is sequentially moved through the plurality of separate workstations of the apparatus *to form a complete upper thereon*; and then the *forming last with the complete upper thereon* is *removably mounted* onto the molding workstation to mold the rubber sole. See the paragraph beginning on pg 9, ln 20 of the instant specification and fig 1. A forming last *with a formed upper thereon* is not removably mounted on the apparatus and then moved sequentially through the plurality of separate workstations to the molding workstation.

4. Claims 21,41,42, and 44-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims introduce new matter

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into the disclosure. The added material which is not supported by the original disclosure is as follows:

a) the phrase "removably mounting the forming last with the formed upper thereon on the apparatus" (cl 21, Ins 10-11) lacks support in the instant specification. There is support for mounting a forming last on the apparatus so that the forming last can pass through the separate workstations to form a complete upper on the forming last.

b) the phrase "moving the last...moulding workstation" (cl 21, Ins 12-13) lacks support in the instant specification. There is support for removable mounting the forming last with the complete upper thereon onto the molding workstation to form a rubber sole on the to the formed upper.

5. Applicant's arguments with respect to claims 21, 41,42, and 44-49 have been considered but are moot in view of the new ground(s) of rejection.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H LEE whose telephone number is 703.305.4019. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD CRISPINO can be reached on 703.308.3853. The fax phone numbers for the organization where this application or proceeding is assigned are

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703.305.7718 for regular communications and 703.305.3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.


EDMUND H LEE
Examiner
Art Unit 1732
6/2/03

EHL
June 2, 2003